

Paragraph 3 and 4 - 35USC103(a) Rejections

In Paragraph 3, claims 1, 4, 6, 7, 9, 10, and 12 stand rejected under 35USC103(a) as being unpatentable over U.S. Patent Number 4,834,393 (Feldi) or French Patent Number 2,594,037 (Musslin) and either in view of the cited Melbye et al., (hereinafter Melbye) and applicant's admission of prior art in the specifications.

In Paragraph 4, claims 8, 11 and 13-15 stand rejected as being unpatentable over Feldi, Musslin, Melbye and applicant's admission of prior art in the specification as applied above in view of U.S. Patent Number 4,993,712 (Urwin).

With respect to the 35USC103(a) rejections of Paragraphs 3 and 4 of this Office Action, the same obviousness rejections had been made to applicant's corresponding claims in the parent application. The independent claims of this application are more limited in scope by reason claims 1 and 10 are prefixed by the words "consisting essentially of" as opposed to the "comprising" claim language of the parent application claims. Claim 1 herein also incorporates the more limited claimed elements of cancelled claims 2-4 of the appealed parent application claims. Claim 10 includes additional claimed limitations and method steps (e.g. step e) not present in the appealed parent application claim 10. Both claims 1 and 10 were deemed allowable and patentable over the prior art by the Board of Appeals. Thus, the issues herein are clearly embodied by the decision and appealed claims duly considered by the Board of Appeals in the parent application. In view of the Board of Appeals decision of Appeal Number 2004-2020, of September 21, 2004, the Board of Appeals clearly failed to sustain the Examiner's rejection of applicant's counterpart claims in the parent application based upon the same 35USC103(a) art rejection and issues. Thus, the grounds for rejecting the applicant's claims herein, has been clearly overruled by the Board of

Appeals and the rejection of these claims should be accordingly withdrawn and a Notice of Allowance should be mailed forthright in view of the clear mandate of the Board of Appeals.

In Paragraph 6, claims 1, 4, and 6-15 stand provisional rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of co-pending Application Number 09/655,743. As acknowledged in the Office Action, the double patenting rejection does not currently apply because no conflicting claims in the parent application have yet been patented. If and when the patent claims in the parent application or this application should become allowable and patentable, the applicant will then undertake the necessary disclaimer or other appropriate action to overcome this provisional double patent action rejection.

The claims are clearly patentably distinct over the art of record as proclaimed by the Board of Appeals. It is respectfully requested that a Notice of Allowance be made in this case.

Dated this 18th day of November, 2004.

Respectfully submitted,

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TENNIS RACQUET EQUIPPED WITH A TENNIS BALL RETRIEVER

This application is a continuing application of U.S. Patent application Serial Number 09/665,743 09/655,743 entitled Tennis Racquet Equipped With a Tennis Ball Retriever filed on behalf of Alice H. Howe on September 6, 2000.